



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Rodney G. Johnson

Examiner:

Mark Beauchaine

Serial No. 10/663,436

Group Art Unit:

3653

Filed: September 15, 2003

Docket No.

PA0891.ap.US

Title: SHUFFLING APPARATUS AND METHOD

MAIL STOP: 313(c)

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**Petition to Have Compact Discs (In Text Form and Video Form as DVD)
Accepted and Reviewed in an Information Disclosure Statement in
Accordance with 37 C.F.R. 1.52, Including at Least section (e), (e)(3)(i),
(e)(4) and (e)(5) or As a Petition to Waive the Rules under 37 C.F.R. 1.183**

37 C.F.R. 1.52(e)(3)(i) States:

(e) Electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding.

(1) The following documents may be submitted to the Office on a compact disc in compliance with this paragraph:

(i) A computer program listing (see §1.96);

(ii) A "Sequence Listing" (submitted under §1.821(c)); or

(iii) Any individual table (see §1.58) if the table is more than 50 pages in length, or if the total number of pages of all of the tables in an application exceeds 100 pages in length, where a table page is a page printed on paper in conformance with paragraph (b) of this section and §1.58(c).

(2) A compact disc as used in this part means a Compact Disc-Read Only Memory (CD-ROM) or a Compact Disc-Recordable (CD-R) in compliance with this paragraph. A CD-ROM is a "read-only" medium on which the data is pressed into the disc so that it cannot be changed or erased. A CD-R is a "write once" medium on which once the data is recorded, it is permanent and cannot be changed or erased.

(3)

(i) Each compact disc must conform to the International Standards Organization (ISO) 9660 standard, and the contents of each compact disc must be in compliance with the American Standard Code for Information Interchange (ASCII). CD-R discs must be finalized so that they are closed to further writing to the CD-R.

(ii) Each compact disc must be enclosed in a hard compact disc case within an unsealed padded and protective mailing envelope and accompanied by a transmittal letter on paper in accordance with paragraph (a) of this section. The transmittal letter must list for each compact disc the machine format (e.g., IBM-

PC, Macintosh), the operating system compatibility (*e.g.*, MS-DOS, MS-Windows, Macintosh, Unix), a list of files contained on the compact disc including their names, sizes in bytes, and dates of creation, plus any other special information that is necessary to identify, maintain, and interpret (*e.g.*, tables in landscape orientation should be identified as landscape orientation or be identified when inquired about) the information on the compact disc. Compact discs submitted to the Office will not be returned to the applicant.

(4) **Any compact disc must be submitted in duplicate** unless it contains only the "Sequence Listing" in computer readable form required by §1.821(e). The compact disc and duplicate copy must be labeled "Copy 1" and "Copy 2," respectively. The transmittal letter which accompanies the compact disc must include a statement that the two compact discs are identical. In the event that the two compact discs are not identical, the Office will use the compact disc labeled "Copy 1" for further processing. Any amendment to the information on a compact disc must be by way of a replacement compact disc in compliance with this paragraph containing the substitute information, and must be accompanied by a statement that the replacement compact disc contains no new matter. The compact disc and copy must be labeled "COPY 1 REPLACEMENT MM/DD/YYYY" (with the month, day and year of creation indicated), and "COPY 2 REPLACEMENT MM/DD/YYYY," respectively.

(5) **The specification must contain an incorporation-by-reference of the material on the compact disc** in a separate paragraph (§1.77(b)(5)), identifying each compact disc by the names of the files contained on each of the compact discs, their date of creation and their sizes in bytes. The Office may require applicant to amend the specification to include in the paper portion any part of the specification previously submitted on compact disc.

(6) A compact disc must also be labeled with the following information:

- (i) The name of each inventor (if known);
- (ii) Title of the invention;
- (iii) The docket number, or application number if known, used by the person filing the application to identify the application; and
- (iv) A creation date of the compact disc.
- (v) If multiple compact discs are submitted, the label shall indicate their order (*e.g.* "1 of X").
- (vi) An indication that the disk is "Copy 1" or "Copy 2" of the submission. See paragraph (b)(4) of this section.

BACKGROUND FACTS

- 1) The accompanying CDs (some with text format and others in Video Format) were submitted to the US Patent and Trademark Office on August 27, 2004 (with a PTO dated stamped receipt of the material dated August 30, 2004).
- 2) In an Office Action mailed April 22, 2005, the PTO acknowledged receipt of the IDS and CDs, but indicated that they were not in compliance with 37 CFR

1.52(e)(3)(i) solely because the formatting of the CD was not acceptable. The Examiner stated that "Each compact disc must conform to the International Standards Organization (ISO) 9660 standard, and the contents of each compact disc must be in compliance with the American Standard Code for Information Interchange (ASCII)."

- 3) No other basis of objection was submitted, and the disks were in finalized form (burned) and could not be rewritten.
- 4) In repeated telephone communication between the Attorney of Record (Mark A. Litman) and the Examiner of Record (Examiner Mark Beauchaine), it was noted and agreed that the CDs were in a readable and in a finalized format.
- 5) An effort was made to evaluate the CDs as they were in the proper format and the DVD format could be readily viewed.
- 6) In spite of efforts to review the CD materials submitted by the Applicants, it was not certain that the CDs could be fully reviewed and signed off on by the PTO in advance of issuance of the Patent.
- 7) To assure technical compliance with review of the IDS properly submitted and in the process of being considered by the PTO, an RCE with a new submission of the CDs has been made.

The Office has a duty, under M.P.E.P §609(C), to consider and respond to Applicants regarding references submitted during pendency of an application. According to the above discussion, Applicant respectfully submits that the Office has not done so in handling of the above referenced application and, therefore, requests that the application be withdrawn from issue under 37 C.F.R. §1.313, after payment of the issue fee. Please contact the undersigned attorney of record if there are any questions related to this matter.

PETITION FOR WAIVER OF THE RULES UNDER 37 C.F.R. 1.183

It is the considered opinion of the below signed Attorney of Record that Rule 1.52 does not apply to submission of Prior Art under 37 CFR 1.57 and 37 CFR 1.58, but is for material that is to become part of the specification, ordinarily by incorporation by reference. Therefore, the excruciating detail and formality imposed by 37 CFR 1.52(e)(5) should not even apply to this submission of reference material under 37 CFR

1.57 and 37CFR1.58. To whatever degree the present submission does not conform to those requirements, and in consideration of the fact that Applicants have made a good faith effort to get all material before the U.S. Patent and Trademark Office in a form that is most convenient to the use of the Examiner and contains all of the information intended for submission in a technically useful and non-eraseable format, the application of Rule 37 CFR 1.52, all sections, should either be deemed inapplicable to the present fact situation, waived-in-part to accept the attached CD information in its offered form, or waived entirely as inapplicable to the submission of IDS material in CD and DVD format.

It is to be noted that the standards and Rules of 37CFR1.52(e)(5) apply (starting from (a)(1)) to documents, and the video recorded depositions of the DVDs are not documents. At a minimum, those items should not be covered by the Draconian and technically irrelevant requirements of 37 CFR 1.52(e), including subsections (4) and (5). Additionally, the requirements of subsection (5) for incorporation by reference into the specification are a further indication that the object and intent of the regulation is immaterial with respect to that regulation. References submitted in a PTO-1449 are not routinely incorporated by reference into Patent Application specifications. Only those references mentioned in the specification are ever incorporated by reference and there is no basis in any other Rule for requiring an Applicant to incorporate-by-reference a work by a third party that is not an inventor.

Thus, it appears that 37 CFR 1.52(e) should be deemed as totally inapplicable as defining a basis for regulated presentation of an IDS in CD or DVD form. Therefore the rule is inapplicable and to whatever degree it is considered to be applicable, Applicants Petitions for a waiver of that Rule.

It is to be further noted that it borders on the physically impossible to convert the video copy of the depositions to document format, as by a frame-by-frame reconstruction of the deposition. As there are approximately 16 frames per second taken in the multiple hour recording of each of the depositions, this would require approximately 43,000 frames or individual documents to be provided for each hour of the four depositions. Additionally, the provision of images would not provide the text, nor the ability of the user to ascertain the demeanor of the presentation, which is a part of the evidentiary value

of the deposition. As such, in the public interest and in the interest of justice, acceptance of the video format is believed to be the best method of receiving this information and it is in the public interest to waive the rules in accordance with 37CFR1.183 and accept the CD format for the IDS herewith submitted.

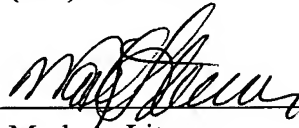
APPLICANTS PETITION

Applicants therefore respectfully petition to have the attached IDS entered into the record of the present Application and to be considered by the Examiner. As the submission in the present form does not appear to be in a manner that is inconsistent with any rule, regulation of law, the IDS should be accepted or all relevant rules waived to accept the IDS in the form proposed.

Respectfully submitted,
Rodney G. Johnson et al.
By Their Representatives,

MARK A. LITMAN & ASSOCIATES, P.A.
York Business Center, Suite 205
3209 West 76th Street
Edina, Minnesota 55435
(952) 832-9090

Date: 25 APRIL 2006

By: 
Mark A. Litman
Reg. No. 26,390

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being facsimile sent by First Class US Mail with postage prepaid and addressed to the United States Patent and Trademark Office, addressed to: Mail Stop 313(c), Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on
APRIL 25 2006.

Mark A. Litman





IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450

SUPPLEMENTAL TRANSMITTAL LETTER

This Supplemental Transmittal Letter is being submitted in compliance with the assumed requirements of 37 C.F.R. 1.51(e)(3), all sections.

As part of those requirements, The Rules state:

(2) A compact disc as used in this part means a Compact Disc-Read Only Memory (CD-ROM) or a Compact Disc-Recordable (CD-R) in compliance with this paragraph. A CD-ROM is a "read-only" medium on which the data is pressed into the disc so that it cannot be changed or erased. A CD-R is a "write once" medium on which once the data is recorded, it is permanent and cannot be changed or erased.

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the Office will use the compact disc labeled "Copy 1" for further processing. Any amendment to the information on a compact disc must be by way of a replacement compact disc in compliance with this paragraph containing the substitute information, and must be accompanied by a statement that the replacement compact disc contains no new matter. The compact disc and copy must be labeled "COPY 1 REPLACEMENT MM/DD/YYYY" (with the month, day and year of creation indicated), and "COPY 2 REPLACEMENT MM/DD/YYYY," respectively.

This Supplemental Transmittal Letter assists in the good faith effort to comply with these requirements.

Listing of Discs (Two Copies of Each Disc)

1. "Shuffler Art" This is a compilation of documents and testimony given in litigation by Shuffle Master, Inc. (the present assignee) and the defendants, CARD and CARD-Austria regarding certain of the Grauzer et al. patents of record. **These files are in pdf (Adobe Acrobat® format) and may be viewed on any Adobe Acrobat® software, 6.0 or higher.**
2. Shuffle Master, Inc. v, Card-Austria et al. Case – Exhibit 1. **These files are in pdf (Adobe Acrobat® format) and may be viewed on any Adobe Acrobat® software, 6.0 or higher.**
3. Shuffle Master, Inc. v, Card-Austria et al. – Recorded Video Deposition of Mr. Luciano. **This file may be viewed on any standard DVD player, including MediaPlayer® software provided with Microsoft Windows® software.**
4. Shuffle Master, Inc. v, Card-Austria et al. – Recorded Video Deposition of Mr. H. Solberg. **This file may be viewed on any standard DVD player, including MediaPlayer® software provided with Microsoft Windows® software.**
5. Shuffle Master, Inc. v, Card-Austria et al. – Recorded Video Deposition of Mr. Robert Morrill, counsel for CARD. **This file may be viewed on any standard DVD player, including MediaPlayer® software provided with Microsoft Windows® software.**
6. Service – User Manual for a Shuffle Master, Inc. shuffler referred to in the industry as the BG-3. **These files are in pdf (Adobe Acrobat® format) and may be viewed on any Adobe Acrobat® software, 6.0 or higher.**
7. Copies of the specifications of two Australian provisional Applications of Rodney Johnson. **These files are in pdf (Adobe Acrobat® format) and may be viewed on any Adobe Acrobat® software, 6.0 or higher.**

Format of Provision

The software format of each CD is identified above. Each of the CDs is labeled appropriately according to 37CFR1.52(e)(3) as follows:

Two CDs are provided for each reference submitted. The two CDs are identical and are therefore labeled **I** and **II** accordingly. The compact disc and copy must be labeled "COPY 1 REPLACEMENT MM/DD/YYYY" (with the month, day and year of creation indicated), and "COPY 2 REPLACEMENT MM/DD/YYYY," respectively.

The dates on the original labels are the label date indicating the actual date of the depositions. The actual date of creation of CD 1 was on or about August 12, 2004, although individual documents in the files of the CD were created on respective dates, each of which was earlier than the date of the manufacture of the CD.

The dates on the original labels are the label date indicating the actual date of the depositions. The actual date of creation of CD 2 was on or about August 12, 2004, although individual documents in the files of the CD were created on respective dates, each of which was earlier than the date of the manufacture of the CD.

The date of creation of CD 6) was on March 2005, although the document itself on that CD was published in 1999.

Respectfully submitted,

Rodney G. Johnson et al.

By Their Representatives,

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3209 West 76th Street
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(952) 832-9090

Date: 25 APRIL 2006

By: 

Mark A. Litman
Reg. No. 26,390

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being facsimile sent by First Class US Mail with postage prepaid and addressed to the United States Patent and Trademark Office, addressed to: Mail Stop 313(c), Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on
APRIL 25 2006.

Mark A. Litman 



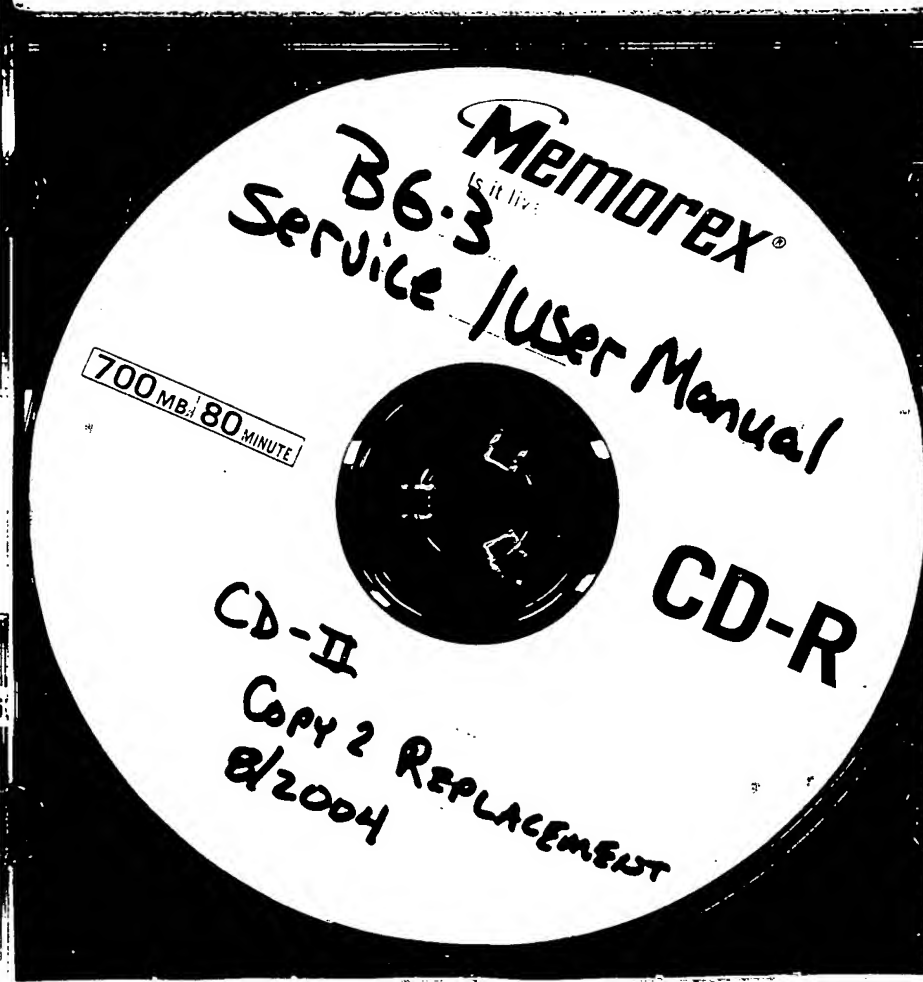
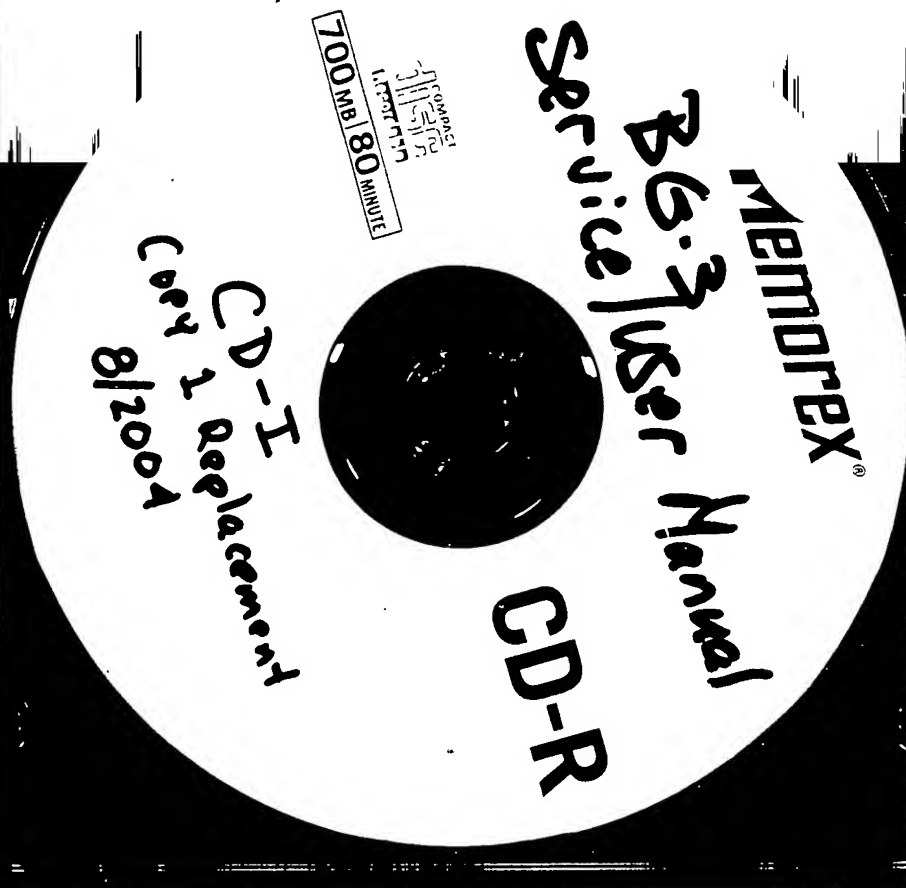
BEST AVAILABLE COPY



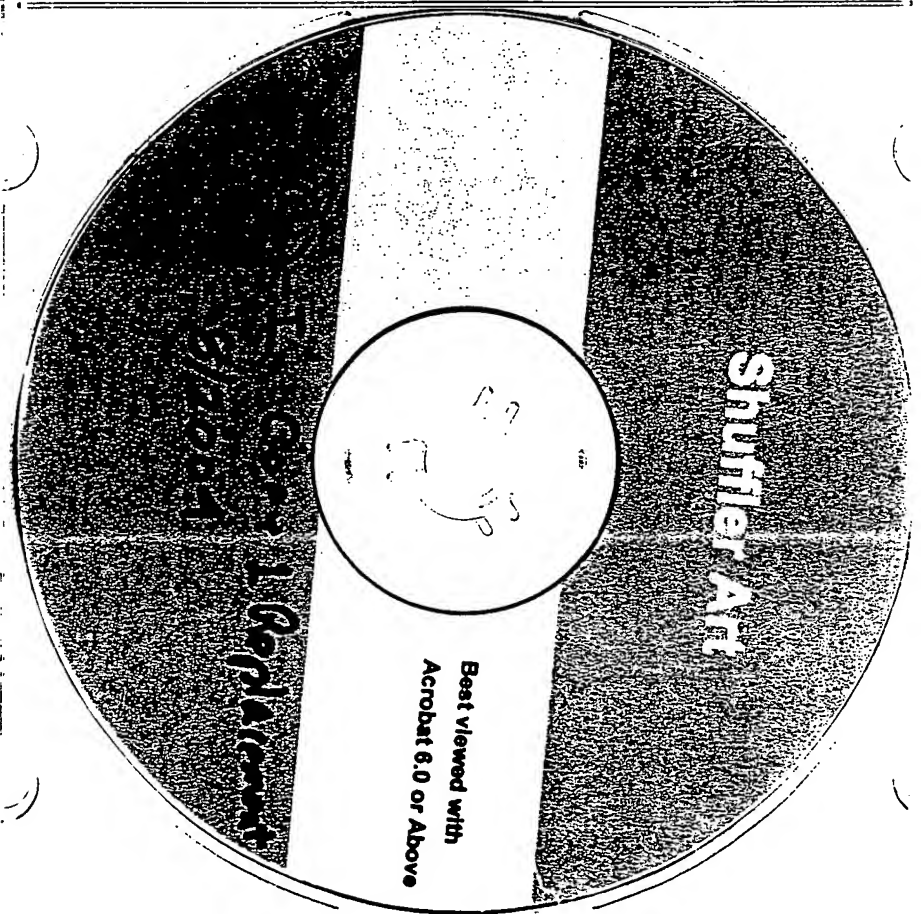
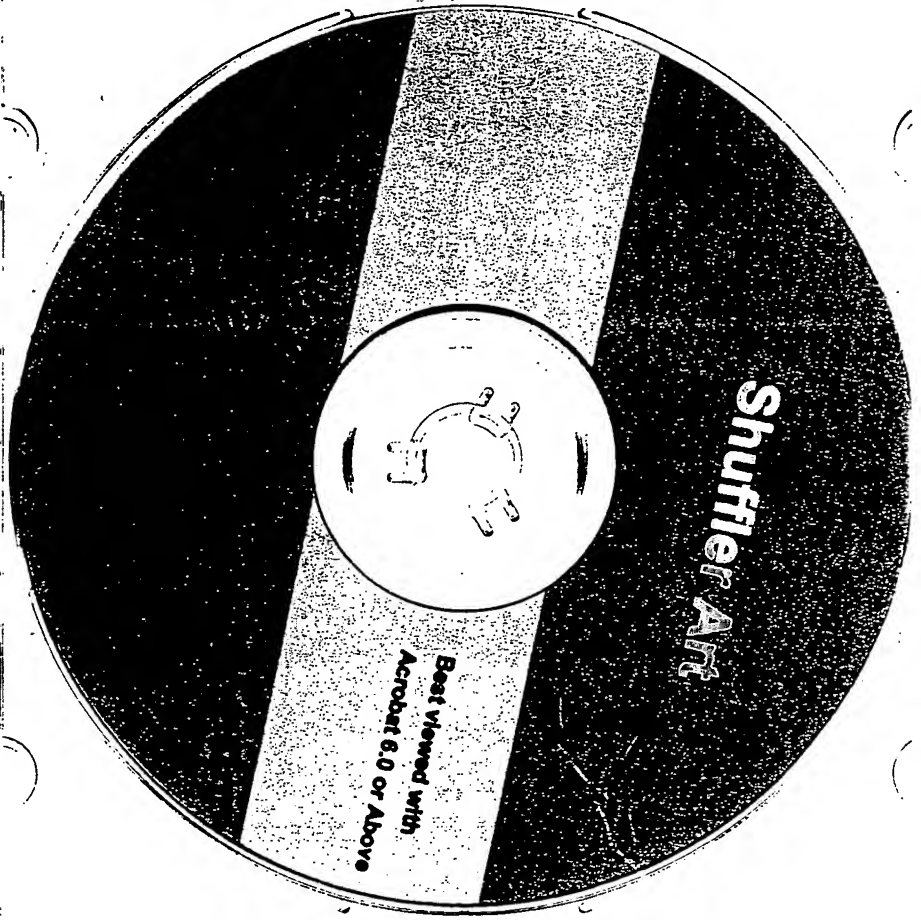
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Specification of Australian Patent Application No.:
31577/95, filed 17 January 1995,
Applicants: Rodney G. Johnson, et al.
Title: Card Handling Apparatus.
Not listed, filed 15 August 1994,
Applicants: Rodney G. Johnson, et al.
Title: Card Handling Apparatus.
PROV. AUSTR
31577/95
2ND AP

2755 52.1

RECU

Memorex

AUSTRALIAN PROV.
PAT. APPS. 31577/95 (4.7.145)
FILED 15 AUGUST 1994

CD-II RECORDING COPY 2

8/2004

BEST AVAILABLE COPY



CD-I
COPY 2
REPLACEMENT
Morrill Decl. Ex. A
Jan. 15, 2004

CARD, LLC v. Shuffle Master, Inc.
No. CV-N-03-0244-ECR-(RAM)

CD-II
COPY 2
REPLACEMENT
Morrill Decl. Ex. A
Jan. 15, 2004

CARD, LLC v. Shuffle Master, Inc.
No. CV-N-03-0244-ECR-(RAM)

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